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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,894	09/16/2005	Volker Stanjek	WAS0707PUSA	7201
22045 7590 12/16/2008 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075				
EXAMINER				
ZEMEL, IRINA SOPHIA				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/549,894

**Applicant(s)**

STANJEK ET AL

**Examiner**

Irina S. Zemel

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-24, 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-27 and 31-22 of copending Application No. 10/468633.

The rejection stands as per reasons of record. It is noted again that the claimed  $A^1-R^1$  end groups of the instant claims are indistinguishable from the alkoxy groups (even if they are now claimed as reactive) of the alkoxysilyl chain ends when  $A^1$  is oxygen and  $R^1$  is an alkyl group defined in the claims as group having as low as 2 carbons, thus fully reading on the  $(OR^2)$  groups in the  $SiR^1_z(OR^2)_{3-z}$  of the referenced co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-21 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/066532 to CONSORTIUM FUR ELEKTROCHEM IND, (hereinafter "Consortium") (of record, a US counterpart application 2004072921 is used as an English language equivalent of Consortium for specific references and examples.

As discussed in the previous office action, Consortium discloses foamable compositions comprising isocyanate-free, alkoxysilane-terminated prepolymer, having silane end groups of the formula fully corresponding to the compound of the claimed formula [2] or prepolymer corresponding to formula [3], and (B) a blowing agent. See, for example, abstract and claims of US PGPub 2004072921. The reference further expressly discloses isocyanate-free composition based on those compounds. Among suitable blowing agents (B) hydrocarbons having 1-5 carbon atoms are expressly disclosed in claim 3 and [0032] as one possible blowing agents species in a group of only three species (that also includes dimethyl ether), and their mixtures, which makes the claimed hydrocarbon blowing agents clearly envisaged from the genus of only three species, as well as the mixture of two out of three species is also clearly envisaged from

the disclosure of [0032]. The reference further expressly discloses .a pressure vessel containing the foamable composition containing components A and B.

As noted above, the claimed  $A^1-R^1$  end groups of the instant claims are indistinguishable from the alkoxy groups of the alkoxysilyl chain ends. When, for example, the claimed  $A^1$  is oxygen and  $R^1$  is an alkyl group of for example, 2 carbon atoms., the claimed  $A^1-R^1$  group fully reads on the  $(OR^2)$  groups in the  $SiR^1_z(OR^2)_{3-z}$  of formula [1] as recited in the reference (and, for example, recited in claims 12 and 13). Therefore, in the absence of distinction between alkoxy groups of the alkoxysilyl and groups and the claimed  $A^1-R^1$  groups, the reference is still considered to be anticipatory reference of the claimed invention.

Therefore, the invention as claimed is still considered to have been anticipated by the cited reference.

### ***Response to Arguments***

Applicant's arguments filed 9-10-2008 have been fully considered but they are not persuasive. The applicants argue that the claimed invention is not obvious from the claims of a co-pending application 10/468,633 because the invention of the instant application "indicate that only 50-99% of the terminal groups of the prepolymer are reactive alkoxysilyl groups. Thus, 1-50% are not reactive alkoxysilyl groups. The presence of unreactive chain termination is necessary to achieve the benefits of the claimed invention. Only methoxy groups, ethoxy groups, and omega-oxyalkylalkyl

radicals are sufficiently reactive with moisture to cure to a foam". The examiner, once again, disagrees with the applicants interpretation of the claims of the instant invention. Even though, 50-99% of the terminal groups of the prepolymer are claimed as reactive alkoxysilyl groups (i.e., moisture condensable), there is absolutely no limitations in the claims that 1-50% are not reactive alkoxysilyl groups. The claimed , 1-50% of chain ends are claimed as the groups of formula A1-R1, and nothing more than that. There is absolutely no implication that those 1-50% groups are either non-reactive or any different from the first claimed 50-99 % moisture curable alkoxysilyl groups. The claims A1-R1 groups read on (OC2H5) groups claimed in the 10/468,633 application.

The applicants present similar arguments with respect to the art rejection of claims 10-21 over WO 02/066532. This argument is also not convincing. As per discussion above, the claimed A1-R1 end groups are indistinguishable from alkoxy groups of the alkoxysilyl chain ends, thus, the cited reference is still considered to anticipate the claimed invention. While the applicants illustrate the claimed compound by a prepolymer having dodecanoxy groups in addition to alkoxysilane groups, nowhere in the claims A<sup>1</sup>-R<sup>1</sup> is required to be either devoid of silicon or to be a reaction product of an alcohol (or another functional monomer) with an isocyanate terminal group of the prepolymer. The newly added limitation of "moisture curable" does not further distinguish A1-R1 groups, as they may be OC2H5 groups as defined in the reference. Which of the terminal groups one elects to name "moisture condensable alkoxysilyl groups", and which A1-R1 is a matter of choice or semantics, but not a claimed limitation distinguishing the claimed groups.

He applicants argue that it is "clear from the specification, addressed to one of ordinary skill in the art, that the -A1-R1 terminal groups are not the same as the reactive alkoxysilyl groups." The examiner does not agree with this statement (as the specification does not provide much more definition of the group A1-R1 than the claims do), however, what is relevant is that the claims do Not provide clear distinction between the claimed groups. As established by the case law, the limitations from the specification should not be read into the claims, and especially when the specification does not provide a clear and specific definition of the groups A1-R1 and also that those groups are being different from the claimed alkoxysilyl groups. Once again, the claimed A1-R1 end group clearly reads of ethoxy group attached to a silicon atom in the terminal groups disclosed by WO reference.

The rejection of claims 10-21 is, therefore, maintained.

***Allowable Subject Matter***

Claims 22-24, 27-28 are allowed.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No prior art of record teaches or fairly suggest an isocyanate-free foamable mixture comprising: (A) a mixture of prepolymers in which 50-99% of the chain ends are terminated by alkoxysilyl groups and 1-50 % of the chain ends are terminated by groups of the formula A1-R1. wherein A is an oxygen atom, an N-R<sup>2</sup> group or a sulfur

atom with proviso that when A<sup>1</sup> is NR<sup>2</sup> or oxygen, A<sup>1</sup> is part of a urea or urethane group, respectively, or R1 is an alkyl or alkenyl group containing 10-18 carbon atoms.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1796

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Primary Examiner  
Art Unit 1796

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